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Kazuhiko Takabayashi

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SCHWARTZ, DARREN B

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,736	Applicant(s) TAKABAYASHI ET AL.	
	Examiner DARREN SCHWARTZ	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009 and 25 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant amends claims 1, 6, 7, 9, 14, 15, 17, 22, 23 and 26.

Claims 1-27 are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 November 2009 has been entered.

Response to Arguments

Applicant's arguments filed 07 October 2009 have been fully considered but they are not persuasive. The Examiner further notes that the remarks presented *infra* by Examiner were presented in the Advisory Action dated 20 October 2009.

Applicant argues on pages 12-13 of Remarks, the art fails to disclose "a local environment management unit configured to authenticate based on the information from the mediating device that the first device and the second device are connected within the certain range when the first device has physically connected to the removable mediating device within a predetermined period of time before or after the removable mediating device is physically connected to the second device."

While the Examiner cannot find the emphasis added to said excerpt of claim 1, the Examiner disagrees and sustains the earlier position. Applicant's and applicant's

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representative are reminded that a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention; see *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) [MPEP: 2141.02 VI].

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues on page 13 of Remarks, "Smith does not disclose or suggest that the check in and check out information, for example, is used for authentication 'that the first device and the second device are connected within the certain range when the first device has physically connected to the removable mediating device within a predetermined period of time before or after the removable mediating device physically connected to the second device' as recited in amended independent claim 1."

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

To clarify, the Examiner applies Smith as teaching "that <<the first device and the second device are connected within the certain range when>> the first device has physically connected to the removable mediating device within a predetermined period of time before or after the removable mediating device physically connected to the

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second device" (emphasis added by Examiner) and the Examiner applies McCorkle as teaching "the first device and the second device are connected within the certain range." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner acknowledges potential amendments to the claims, the Examiner believes the newly presented subject matter of amended claim 1 is rendered obvious by the combination of references. Particularly previously applied reference, Okamoto (U.S. Pat 6854062), hereinafter referred to as Okamoto.

Okamoto teaches "wherein the first device reads information from the removable mediating device or the first device stores the information in the removable mediating device" in column 4, lines 62-67; Okamoto explicitly discloses "... PC5 downloads data from the outside device 3, and that these data are stored in the bridging medium 4 using the reader/writer 5"

Okamoto teaches "wherein the second device reads the information from the removable mediating device or the second device stores the information in the removable mediating device" in column 5, lines 1-7; Okamoto explicitly discloses "First, in the household device 2, the bridging medium 4 is detected to be inserted in to the bridging medium reader 25 (YES in step 1001). Then, the bridging medium reader 25 reads the data stored in the bridging medium 4, ..."

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The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 6-12, 14-20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Pat 6854062 B2), hereinafter referred to as Okamoto, in view of Smith, II et al (U.S. Pat 5884298 A), hereinafter referred to as Smith, in further view of McCorkle et al (U.S. Pat Pub 2004/0203600 A1), hereinafter referred to as McCorkle.

Re claims 1 and 9: Okamoto teaches a device-to-device authentication system for authenticating when devices on a network are connected within a certain range, comprising:

a first device [Fig 1, elt 5: PC] comprising:

a first mediating device interface [Fig 1, elt 6: READER/WRITER] for physically connecting a removable mediating device [Fig 1, elt 4: BRIDGING MEDIUM] (col 3, lines 19-23), wherein the first device reads information from the removable mediating device or the first device stores the information in the removable mediating device (col 4, lines 62-67),

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a second device [Fig 1, elt 2 & Fig 3, elt 2: HOUSEHOLD DEVICE] comprising:

a second mediating device interface [Fig 3, elt 25: BRIDGING MEDIUM

READER] for physically connecting the removable mediating device [Fig 1, elt 4 & Fig 3, elt 4: BRIDGING MEDIUM] (col 4, lines 53-54), wherein the second device reads the information from the removable mediating device or the second device stores the information in the removable mediating device (col 5, lines 1-7);

a network interface unit [Fig 3, elt 24 & "HOUSEHOLD NETWORK"] configured to receive a request for authentication over the network ["HOUSEHOLD NETWORK," col 4, lines 45-50] (Fig 4, all elts: col 5, lines 8-15);

local environment management means, based on the information from the mediating device, configured to authenticate (col 4, line 62 – col 5, line 7);

However, Smith teaches:

local environment management means for authenticating that the first device has physically connected to the removable mediating device within a predetermined period of time before or after the removable mediating device physically connected to the second device (col 33, lines 58 – col 34, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto with the teachings of Smith, for the purpose of calculating usage time of content that has been checked-out.

The combination of Okamoto and Smith teaches: wherein the first device can use content when the first device is authenticated (Okamoto: Fig 1010 & 1011: col 5, lines 51-60).

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However, the combination of Okamoto and Smith does not expressly disclose the first device and the second device are connected within the certain range.

Yet, McCorkle teaches the first device and the second device are connected within the certain range (Fig 3; ¶8; ¶15; ¶18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto and Smith with the teachings of McCorkle, for the purpose of providing a wireless environment and for providing mobility & portability, as is known in the art.

Re claims 2 and 10: The combination of Okamoto, Smith and McCorkle teaches: the second device is a home server (Okamoto: Fig 3: col 4, lines 16-21), the first device is a client for making a request for the content to the home server and in response to authentication of the client, the home server provides the content and/or issues a license for the content the client (Smith: Fig 2).

Re claims 3 and 11: The combination of Okamoto, Smith and McCorkle teaches: two or more home servers are able to be installed on the network and at least one of the home servers provides the content and/or issues a license for the content to a client that is authenticated (Okamoto: Fig 1, elts 1, 2, 3, & 5; see also Okamoto Fig 1, elts “OUTSIDE NETWORK” and “HOUSEHOLD NETWORK;” Smith: Fig 2; col 1, lines 58-65).

Re claims 4 and 12: The combination of Okamoto, Smith and McCorkle teaches: the client is able to be receive provision of the content and/or issuance of the license

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from least one of the two or more home servers on the network (Okamoto: Fig 4, elts 1005, 1008, 1009, 1010, 1011 & 1012) (Smith: Fig 2).

Re claims 6 and 14: The combination of Okamoto, Smith and McCorkle teaches the predetermined identification information for determining that the first and the second device have connected to the removable mediating device within the predetermined period of time (Smith: col 33, lines 58 – col 34, line 8).

Re claims 7 and 15: The combination of Okamoto, Smith and McCorkle teaches the information comprises confidential information for determining that the first and the second device have connected to the removable mediating device within the predetermined period of time; and the removable mediating device comprises a memory for retaining the confidential information in a secure manner (Okamoto Fig 1, particularly elts 2, 4 & 6; Smith: col 43, lines 22-29).

Re claims 8 and 16: The combination of Okamoto, Smith and McCorkle teaches the confidential information is erased after the predetermined period of time elapses (Smith: col 11, lines 38-50).

Re claim 17: Okamoto teaches a communication apparatus for using content on a network within a predetermined allowable range, comprising:

a mediating device interface [Fig 3, elt 25: BRIDGING MEDIUM READER] for physically connecting a removable mediating device [Fig 1, elt 4 & Fig 3, elt 4: BRIDGING MEDIUM] (col 4, lines 53-54),

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a network interface [Fig 3, elt 24 & "HOUSEHOLD NETWORK"] for receiving or transmitting a request for authentication over the network ["HOUSEHOLD NETWORK;" col 4, lines 45-50] (Fig 4, all elts: col 5, lines 8-15);

a communication unit for storing information in the removable mediating device or for reading the information from the removable mediating device (col 4, lines 62-67);

a local environment management unit configured to authenticate, based on the information (col 4, line 62 – col 5, line 7);

However, Smith teaches:

a local environment management unit configured to authenticate that the apparatus and a device have physically connected to the mediating device within a predetermined period of time between connections, to control the use of the content (col 33, lines 58 – col 34, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto with the teachings of Smith, for the purpose of calculating usage time of content that has been checked-out.

However, the combination of Okamoto and Smith does not expressly disclose the apparatus is within the predetermined allowable range.

Yet, McCorkle teaches the apparatus is within the predetermined allowable range (Fig 3; ¶8; ¶15; ¶18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto and Smith with the

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teachings of McCorkle, for the purpose of providing a wireless environment and for providing mobility & portability, as is known in the art.

Re claim 18: The combination of Okamoto, Smith and McCorkle teaches: a unit configured to receive the content and/or issuing a license for the content when the device and the apparatus are authenticated, wherein the communication apparatus operates as a home server for providing content on the network (Okamoto: col 5, lines 8-37) (Smith: Fig 2).

Re claim 19: The combination of Okamoto, Smith and McCorkle teaches: a unit configured to receive the content and/or a license for the content when the device and the apparatus are authenticated, wherein the communication apparatus operates as a client for making a request for the content to a home server on the network (Okamoto: Fig 2, see at least elts 1002 & 1003; col 5, lines 8-37) (Smith: Fig 2).

Re claim 20: The combination of Okamoto, Smith and McCorkle teaches: the means for receiving receives provision of the content and/or issuance of a license for the contents from the two or more home servers authenticated by the local environment management means (Smith: Fig 2; col 1, lines 58-65).

Re claim 22: The combination of Okamoto, Smith and McCorkle teaches the information comprises predetermined identification information for determining that the communication apparatus and another device have connected to the removable mediating device within the predetermined period of time (Smith: col 33, lines 58 – col 34, line 8).

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Re claim 23: Claim 23 is rejected under similar grounds as those provided in claims 7 and 15.

Re claim 24: The combination of Okamoto, Smith and McCorkle teaches: the local environment management unit authenticates that the another device, which reads same confidential information from the mediating device and/or reads confidential information within a predetermined period of time, is located in the local environment of the local environment management means (Smith: col 33, lines 58 – col 34, line 8).

Re claim 25: Claim 25 is rejected under similar grounds as those provided in claims 6 and 16.

Re claim 26: Okamoto teaches a computer-readable medium storing a program for causing a computer to execute a method for authenticating whether or not devices on a network are connected within a certain scope (col 11, lines 37-48), the method comprising:

receiving a request for authentication over the network (Fig 4, all elts: col 5, lines 8-15);

authenticating, based on information stored in a removable mediating device (col 4, lines 62-67), that a first device physically connected to the removable mediating device (Fig 4, elts 1001, 1002, 1003, 1004, 1005, 1006 & 1007) allowing the first device to use content when the first device is authenticated (Fig 4, elts 1009, 1010, 1011 & 1012).

However Smith teaches within a predetermined period of time before or after the removable mediating device physically connected to the second device (col 33, lines 58 – col 34, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto with the teachings of Smith, for the purpose of calculating usage time of content that has been checked-out.

However, the combination of Okamoto and Smith does not expressly disclose a first device and a second device are connected within a certain scope.

Yet, McCorkle teaches a first device and a second device are connected within a certain scope (Fig 3; ¶8; ¶15; ¶18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto and Smith with the teachings of McCorkle, for the purpose of providing a wireless environment and for providing mobility & portability, as is known in the art.

2. Claims 5, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Pat 6854062 B2), hereinafter referred to as Okamoto, Smith, II et al (U.S. Pat 5884298 A), hereinafter referred to as Smith, McCorkle et al (U.S. Pat Pub 2004/0203600 A1), hereinafter referred to as McCorkle, in further view of Katsuda et al (U.S. Pat Pub 2003/0046352 A1), hereinafter referred to as Katsuda.

Re claims 5, 13 and 21: The combination of Okamoto, Smith and McCorkle teaches all the limitations of claims 3, 11 and 21 as previously discussed.

Katsuda teaches wherein upon connection to a home server on a second network, the client is not able to use the content from the two or more home servers (entire Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto, Smith and McCorkle with the teachings of Katsuda, for the purpose of protecting digital content and disallowing its use outside a designated network, as taught by Katsuda (see Katsuda Abstract).

3. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Pat 6854062 B2), hereinafter referred to as Okamoto, Smith, II et al (U.S. Pat 5884298 A), hereinafter referred to as Smith, McCorkle et al (U.S. Pat Pub 2004/0203600 A1), hereinafter referred to as McCorkle, in further view of Jinriki et al (JP 2002-281019 A), hereinafter referred to as Jinriki. A translated copy of Jinriki et al., JP 2002-281019 A has been provided with this Office Action.

Re claim 27: The combination of Okamoto, Smith and McCorkle teaches all the limitations of claim 9 as previously discussed.

Jinriki teaches writing a temporary random number to the mediating device (page 5, bottom line – page 6, top line; page 6, lines 4-5; ¶11); reading the temporary random number from the mediating device (page 5, bottom line – page 6, top line; ¶24); and collating the temporary random number (page 5, lines 2-3; page 6, lines 7-8; ¶11; ¶24).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto, Smith and McCorkle with the teachings of Jinriki, for the purpose of authenticating portable devices, as taught by Jinriki (page 1, line 1; page 3, ¶2).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 7am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435